

REMARKS

The Examiner has rejected claims 1-6, 9, 11-14, 17 and 19-24 under 35 U.S.C. §103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view of Roskin (U.S. Patent No. 7,000,347) and Bergevin (U.S. Patent No. 5,586,408); claims 7, 8, 15, and 16 under 35 U.S.C. §103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view of Roskin (U.S. Patent No. 7,000,347), Bergevin (U.S. Patent No. 5,586,408) and Skuba (U.S. Patent No. 6,336,291); claims 10 and 18 under 35 U.S.C. §103(a) as being unpatentable over Woolbright (U.S. Patent No. 5,658,098) in view of Roskin (U.S. Patent No. 7,000,347), Bergevin (U.S. Patent No. 5,586,408) and White-Wexler et al (U.S. Patent No. 5,501,040); and 1-7 and 9-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,571,529 in view of Bergevin; claims 1-4, 13, 15 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,695,544 in view of Bergevin; and claims 13-15, and 17-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,817,154 in view of Bergevin. In response, Applicants respectfully traverse the above-mentioned rejections and respectfully request reconsideration by the Examiner in view of the following remarks.

With regards to the rejection of the claims 1-24, particularly independent claims 1 and 13, under 35 U.S.C. §103(a) as being unpatentable over Woolbright in view of two or more of Roskin, Bergevin, Skuba and White-Wexler, the Applicant respectfully traverses the Examiners suggestion that Woolbright includes all of the limitation of the presently claimed invention except for a top panel, vegetation seeds (limitation of claim 13) and a plurality of apertures positioned on the top panel (limitation may also or alternatively include apertures

positioned on the wall assembly). The Applicant notes that Woolbright does not disclose or suggest a multitude of other limitations identified in the claims. For example, the primary reference, Woolbright '098, fails to disclose limitations including, but not limited to, the following: 1) a deterioration resistant retaining wall having planter blocks with top panels, 2) a deterioration resistant retaining wall having planter blocks including "*chambers*" for receiving and retaining fill material and seeds and/or vegetation, 3) a deterioration resistant retaining wall having planter blocks with wall assemblies that include at least one wall that borders each edge of the periphery of the planter blocks, and 4) a deterioration resistant retaining wall that includes one or more apertures positioned on the top panel or wall assembly to allow vegetation to visibly grow to the exterior of the planter block wall.

The Examiner bears the initial burden in establishing a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103. In re Piasecki, 745 F.2d 1468, 223 USPQ 758 (Fed. Cir. 1985); In re Reuter, 651 F.2d 751, 210 USPQ 249 (CCPA 1981). If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness.

To properly establish a prima facie case of obviousness, MPEP § 706.02(j) identifies three basic criteria that must be met. First, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. Second, there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. Finally, there must be a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As previously suggested, a prima facie case of obviousness concerning the present application has not been established since the references cited by the Examiner do not disclose all of the claim limitations in the present application. The planter block of the present invention includes a wall assembly that is adjoined to the top panel and bottom panel to form a *chamber* for receiving and retaining fill material. Chamber is generally understood in the present application to be an enclosed space or compartment. The forming of a chamber in the present invention by adjoining the wall assembly with the top panel and bottom panel provides added stabilization of the walls of the planter block, especially when filled. The applicant should also note that even though an enclosed chamber is formed, one or more walls and/or panels of the wall assembly, top panel and bottom panel may include one or more apertures. Furthermore, the presence of opposing walls in the wall assembly and/or a top panel opposite a bottom panel assists in providing rigidity to the outer walls and/or panels of the block upon filling wherein the pressure created by the fill material within the chamber adds structure and stabilizes the adjacent walls and/or panels. Also, in various embodiments, the presence of the wall assembly having at least one wall that borders each side of the planter block and a top and bottom panel enhances the retention of the fill material during filling and over time when movement of the fill material may occur. The building block disclosed in Woolbright fails to disclose a top panel and additionally fails to disclose a building block with a wall bordering the back of the block. Such omissions in structure reduce the stability of the building block and also reduce the retention of the fill material during filling and over time. Finally, the adjoinment of a top and bottom wall to the side walls and/or a front wall and back wall to the side walls provides additional mechanical stability to the planter block of the present invention, even if not filled or under-filled, thereby reducing the chances of collapse and/or structural failure of a wall constructed of such planter blocks.

Woolbright and the other cited references also do not disclose or suggest a deterioration resistant retaining wall and a method of constructing such a wall that includes a plurality of planter blocks that have one or more apertures positioned on the top panel or wall assembly of the block to allow vegetation to visibly grow to the exterior of the planter block wall. The intention of the present invention is to provide a vegetated wall structure that can stabilize and/or prevent erosion or movement of a sloped or rugged surface or terrain or provide a vegetated wall structure that can act as a barrier. As previously explained, the inclusion of a top panel and wall assembly of the planter block assist in forming a rigid product that provides a barrier to earth movement caused by elements, such as gravity or water erosion while still allowing for vegetative growth to the visible surface of the retaining wall. Woolbright fails to disclose or suggest such a retaining wall or method of constructing such a wall that can provide the structural integrity of the claimed retaining wall, which functions to protect the terrain from earth movement and/or water erosion and additionally provides vegetative growth to the visible surface.

The Examiner has also failed to provide a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103 by failing to provide an adequate suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F/2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Nothing identified in the cited references provided by the Examiner would suggest their combination to provide for the methods of constructing a retaining wall structure

and for a retaining wall that stabilizes a sloped terrain or provides a structural barrier and is further intended to display vegetation to its visible surface. Woolbright is the only reference directed to a retaining wall. As previously mentioned, Woolbright does not provide the structural limitations of the claimed invention and further does not disclose or suggest the vegetation of each of the building blocks of the wall. While Woolbright discloses the potential for root growth to stabilize the wall, it does not disclose or suggest apertures positioned for visible vegetative growth of each building block since such apertures for growth are found only on the back bottom panel away from the visible portions of each building block.

Furthermore, the Examiner has utilized four secondary references, Roskin, Bergevin, Skuba and White-Wexler that are not directed to nor disclose or suggest retaining wall construction or retaining walls. Moreover, the four secondary references are not related to nor disclose or suggest vegetated retaining walls and the method of constructing such vegetated walls. For example, Roskin has been cited to address Woolbright's omission of a top panel and White-Wexler has been cited to address Woolbright's omission of interior partitions in the retaining wall blocks of the present invention. However, Roskin discloses a vase for cut flowers and White-Wexler discloses flower pots or planters. A person of ordinary skill in the art would not look to the flower vase or flower pot technology for suggestions related to structural limitations of a retaining wall, such as a top panel or interior partition. Vases for cut flowers and flower pots or planters are generally not considered as building materials and would not be considered by a person of ordinary skill in the art as references that would provide guidance on such technology. Additionally, Bergevin and Skuba are directed to vegetated matting materials and are not related to structural building materials, particularly those utilized in the construction of retaining walls. Therefore, a person of ordinary skill in the art would not look to these

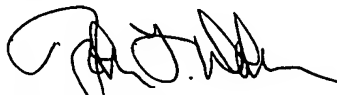
references for guidance in vegetated retaining wall technology and the construction steps for such walls. In view of the above remarks, the Applicants respectfully request that the Examiner reconsider the rejection of the pending claims and find claims 1-24 allowable.

The Examiner has also provisionally rejected claims 1-7, 9-13, and 15-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent Nos. 6,571,529, 6,695,544 or 6,817,154 in view of Bergevin. The Applicants respectfully traverse the rejection and disagree with the Examiners assertion that “it would have been obvious to those of ordinary skill in the art of retaining walls at the time the invention was made to modify the device claimed in either the ‘529, ‘544 or ‘144 references such that it would include a plurality of apertures”. However, to advance prosecution of this Application and to obtain allowance on allowable claims at the earliest possible date, the Applicants agree to file a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome the rejection based on nonstatutory double patenting upon receiving notice of the allowability of the claims. It is noted that no admission may be inferred by this response or any terminal disclaimer filed in the present application and the Applicants reserve the right to pursue similar claims in the future.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



John F. Dolan
Registration No. 45,382

Customer No. 22859
FREDRIKSON & BYRON, P.A.
200 South Sixth Street, Suite 4000
Minneapolis, MN 55402-1425 USA
Telephone: (612) 492-7000
Facsimile: (612) 492-7077

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 06-1910.

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as First Class Mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on

September 18, 2006
Date of Deposit


Joleen R. Krueger